

II. REMARKS/ARGUMENTS

These Remarks are in response to the Final Office Action mailed April 5, 2005 (hereafter, "Final Office Action"). No fee is due for the addition of any new claims.

Claims 1-23 were pending in the Application prior to the outstanding Final Office Action dated April 5, 2005. The Final Office Action rejected claims 1-23. The present response replies to the rejections, leaving for the Examiner's present consideration claims 1-23. Reconsideration of the rejections is respectfully requested.

A. Preliminary Matters

As preliminary matters, the Final Office Action, like the previous Office Action mailed October 4, 2004 (hereafter, "previous Office Action"), does not contain any grounds for rejection of claim 14. Nor does the Final Office Action contain any detailed reasons supporting rejection of claim 14. However, claim 14 is listed as rejected, along with all other claims, in the Final Office Action Summary. The additional limitations of claim 14, relating to a return address, are not contained in any other claim, and therefore are not addressed anywhere in the Final Office Action. Applicants therefore assume and will proceed under the assumption that the Final Office Action intends to include claim 14 among the rejected claims based on the reasons for rejection of the underlying independent claim 11. Secondly, Applicants assume that the numerous references in the Final Office Action to figures or to column and line numbers of an unspecified source intend to refer to Tilden, Jr. (U.S. Patent 6,449,635; hereafter, *Tilden, Jr.*). Finally, Applicants respectfully note that the Final Office action refers to an amendment filed on February 10, 2005. Our last reply in this case ("Reply A") was filed on December 30, 2004. Applicants assume that all comments in the Final Office Action are intended to refer to this reply. Applicants respectfully request that the Examiner inform them by telephone at the phone number given below if they are mistaken in one or more of these assumptions.

Applicants note a reference (p.2, section 2, paragraph 2) to "Figs. And 4." Applicants are uncertain as to the figures to which the Final Office Action intends to refer by this reference and thus

Application No. 09/888,298
Xerox Ref.: D/A 1053
Atty. Docket No.: XERX-01051US0
SSvoboda/XERX/1051us0/Reply A as filed

respectfully regret that they are unable to address these reference(s) in this reply. Applicants respectfully request that it be clarified to which figures the Final Office Action intended to refer.

B. Request for Consideration of Previously Submitted IDSs

Applicants have submitted two Information Disclosure Statements (IDS) to the USPTO, which were stamped as received by the USPTO on June 27, 2002 and April 5, 2004, respectively.

With regard to the IDS received-dated June 27, 2002, applicants have not yet been provided with an initialed Form PTO-1449 (substitute) indicating consideration of the references therein by the Examiner. Accordingly, a date stamped copy of this IDS is enclosed, and it is respectfully requested that the Examiner provide to Applicants an initialed copy of Form PTO-1449 (substitute) indicating consideration of the references therein by the Examiner.

With regard to the IDS received-dated April 5, 2004, applicants have not yet been provided with an initialed Form PTO/SB/08B indicating consideration of the references therein by the Examiner. Accordingly, a date stamped copy of this submission is enclosed, and it is respectfully requested that the Examiner provide to Applicants an initialed copy of Form PTO/SB/08B indicating consideration of the references therein by the Examiner.

C. Reply to Response to Arguments

The Final Office Action comments (page 3, section 3, paragraph 2 and again at page 3, section 4, paragraph 2) on the test for obviousness under *In re Keller*. Applicants respectfully thank the Final Office Action for noting this case. Applicants respectfully note their familiarity with the fact that the tests for obviousness is what the combined teaching of the references would have suggested to those of ordinary skill in the art.

Applicants respectfully note that our remarks on pages 13-15 of Reply A dated December 30, 2004 (hereafter, "Reply A") did not suggest that the test for obviousness was whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. Applicants respectfully further note that our remarks on pages 13-15 did not suggest that the claimed invention must be expressly suggested in any one or all of the references. Applicants respectfully

further note that our remarks on pages 13-15 did not suggest that one can show nonobviousness by attacking references individually where the rejections are based on combinations of references. Applicants respectfully request that the Examiner provide Applicants with specific citations to Reply A (or to this Reply) that in the Examiner's view make one or more of these suggestions.

Rather, Applicants respectfully demonstrated through our remarks that certain statements of the previous Office Action, which are repeated in the Final Office Action, are not consistent with the cited references and with the current claims. For example, Applicants discussed why the following suggestions in the previous Office Action are not consistent with the references and current claims:

1. With regard to claims 4 and 10, the previous and Final Office Actions suggest (p. 7, 2nd paragraph and p. 11, 1st paragraph) that Borenstein discloses determining an application provider at "page 4, lines 1-6."
2. With regard to claim 6, the previous Office Action suggests (p. 8, 3rd paragraph) that *Tilden, Jr.* (col. 6, lines 18-25) teaches a script program which contains a command which performs a task in response to a user's request. (Applicants note that the Final Office Action concedes (pp. 3-4, section 5) that the previously cited section of *Tilden, Jr.* does not "accentuate" the disclosure such a script program. Applicants discuss below the sections of *Tilden, Jr.* [col. 2, lines 7-8, 13-19, 27-29, and 51-54] that are newly cited for this disclosure by the Final Office Action.)
3. With regard to claims 11-12, the previous and Final Office Actions suggest (p. 9, 4th paragraph and p. 10, 2nd paragraph) that Borenstein (page 4, lines 13-17) discloses alteration of the destination address.

Applicants respectfully suggest that such remarks are proper in a reply to an office action. Such remarks demonstrate why a number of suggestions put forth by the previous Office Action (and by the Final Office Action) to support a rejection are not supported by the cited references and current claims. Applicant's remarks support the conclusion that the combined teachings of the cited references would not have suggested the current claims to those of ordinary skill in the art. Applicants respectfully note the logic that if a certain suggestion merits inclusion in an office action as purportedly supporting a rejection, it merits rebuttal in a reply to an office action opposing that same rejection.

Finally, as mentioned above, with regard to claim 6, the Final Office Action concedes (pp. 3-4, section 5) that the previously cited section of *Tilden, Jr.* does not "accentuate" the disclosure such a script program. However, the Office Action states (pp. 3-4, section 5) that this disclosure is made in other sections of *Tilden, Jr.* (col. 2, lines 7-8, 13-19, 27-29, and 51-54). However, Applicants respectfully submit that none of these four passages from *Tilden, Jr.* cited by the Final Office Action contain the disclosure for which they are cited. The first section of *Tilden, Jr.* cited by the Final Office Action (col. 2, lines 7-8) discloses that features that can be included in the system are visual notification that the expansion is complete without either being taken to a different web page if in a web page environment or without invoking a web browser if in an e-mail environment. The second section of *Tilden, Jr.* cited by the Final Office Action (col. 2, lines 13-19) discloses means for storing a script program as a portion of a first source file; means for storing a *predefined* message as a second source file; means for including in the script program a command that displays the *predefined* message by retrieving the second source file; and means for directing the first source file to an email address of a user [emphasis added]. The third section of *Tilden, Jr.* cited by the Final Office Action (col. 2, lines 27-29) discloses that the system can further include means for including in the script program a command for passing information to the server computer; [and] means for including in the script program a command for replacing a first image with a second image. The fourth section of *Tilden, Jr.* cited by the Final Office Action (col. 2, lines 51-54) discloses receiving the main message into each of the secondary messages upon execution of the script program, and further discloses that the step of providing a script program can include a command for transmitting tracking information to the server computer upon execution of the script program. While some of these passages mention a script program, contrary to the suggestion of the Final Office Action, none of them makes any disclosure regarding a script program that contains a command that performs a task *in response to a user's request*. For example, the second section of *Tilden, Jr.* cited by the Final Office Action (col. 2, lines 13-19) discloses means for storing a script program as a portion of a first source file; means for storing a *predefined* message as a second source file; means for including in the script program a command that displays the *predefined* message by retrieving the second source file; and means for directing the first source file to an email address of a user [emphasis added].

D. **Claim Rejections Under 35 U.S.C. § 102(e)**

Claims 1-3, 8, 9, 13, and 15-23 were rejected under 35 U.S.C. §102(e) as being anticipated by *Tilden, Jr.* It is respectfully submitted that *Tilden, Jr.* does not anticipate the invention as claimed. *Tilden, Jr.* teaches a data distribution system for deploying email using short email messages, which when opened call a large body of information from a server computer that includes a script program. The server computer and script program are necessarily under the control of the entity operating the invention. The stated principal application of the invention is the bulk sending of and subsequent user receipt verification of commercial electronic mail messages, commonly known as "spam." By contrast, the current claims describe an invention that allows a user to enhance the functionality of an email message by integrating the computation and functionality available through the Internet and elsewhere with a user's email message transmission.

Claims 1 and 17 were rejected as unpatentable over *Tilden, Jr.* Applicants respectfully traverse the rejections. The current claims, unlike *Tilden, Jr.*, are not limited to making use of information on a user's website. Rather, the current claims allow integration of functions and capabilities available on *any* website located *anywhere* in the world, with no limitation on the identity of the website's operator. Moreover, the current claims do not describe merely a method for increasing the size of email advertisements following their receipt and tracking their receipt. By contrast, the current claims describe a robust method, article of manufacture, and apparatus for powerfully leveraging the virtually limitless capabilities of the Internet by permitting a user to avoid having to separately, manually travel to Internet sites to perform steps involved in composing an electronic mail message. The desired steps involving Internet access are automatically performed following receipt of the message according to the claims.

Tilden, Jr. fails to disclose all of the limitations of claims 1 and 17. Claims 2-10 and 18-23 each ultimately depend from one of these independent claims and are believed patentable for at least the same reasons as the independent claims and because of additional limitations of these claims.

Accordingly, claims 1-10 and 17-23 are believed patentable over the cited reference and withdrawal of the rejections is respectfully requested.

E. **Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 4-7 and 11-12 were rejected under 35 U.S.C. § 103(a) as being disclosed by *Tilden, Jr.* in view of Borenstein (WO 92/22033; hereafter, "Borenstein"). Claim 10 was rejected under 35 U.S.C. § 103(a) as being disclosed by *Tilden, Jr.* in view of Borenstein and further in view of Richard (U.S. Patent 6,728,711; hereafter, *Richard*). Applicants respectfully traverse the rejections of claims 4, 6, 10, and 11-12.

The references cited in the Final Office Action, including *Tilden, Jr.* and Borenstein, either singly or in combination, fail to disclose all of the limitations of claims 4, 6, and 11-12. The references cited in the Final Office Action, including *Tilden, Jr.*, Borenstein, and *Richard*, either singly or in combination, also fail to disclose all of the limitations of claim 10.

With regard to claims 4 and 10, the Final Office Action concedes (p. 8, 2nd paragraph and p. 11, last paragraph) that *Tilden, Jr.* does not disclose determining an application provider. However, the Final Office Action states (p. 8, 2nd paragraph and p. 11, last paragraph) that Borenstein discloses determining an application provider at "page 4, lines 1-6." The cited section of Borenstein discloses that an active message can be received at one organizational center for asking a few questions to collect certain information, after which the active message sends itself off to the next link in the organizational chain. As examples, Borenstein discloses that expense vouchers, purchase orders, and insurance claims can be processed in this manner. Contrary to the suggestion of the Final Office Action, the cited section of Borenstein makes no disclosure regarding determining an application provider.

With regard to claim 6, the Final Office Action states (p. 9, 2nd paragraph) that *Tilden, Jr.* (col. 6, lines 18-25) teaches a script program which contains a command which performs a task in response to a user's request. However, Applicants note that the Final Office Action concedes (pp. 3-4, section 5) that this section of *Tilden, Jr.* does not "accentuate" the disclosure such a script program. Moreover, the cited section of *Tilden, Jr.* discloses that program control is passed to a test task step following the processing tracking step, looping thereat until information passed from the subscriber computer is received, whereupon a transaction task is performed in response to the user's

request in a do task step. The cited section of *Tilden, Jr.* further discloses that the task step could be filling of an order for products or services, or anything else that would be an appropriate response to the user input. Contrary to the suggestion of the previous Office Action, this section discloses nothing regarding a script program containing a command that performs a task in response to a user's request.

With regard to claims 11-12, the Final Office Action concedes (p. 10, 3rd paragraph and p. 10, last paragraph—p. 11, 1st paragraph) that *Tilden, Jr.* does not disclose alteration of the destination address. However, the Final Office Action states (p. 10, 3rd paragraph and p. 11, 1st paragraph) that Borenstein (page 4, lines 13-17) discloses alteration of the destination address. However, the cited section of Borenstein discloses that even more insidiously, one could create a mail based virus that could bring any computer network to its knees, simply by mailing out two copies of itself every time it is received by a recipient. Contrary to the suggestion of the Final Office Action, this section discloses nothing regarding alteration of the destination address.

Claims 12-16 each ultimately depend from independent claim 11 and are believed patentable for at least the same reasons as the independent claims and because of additional limitations of these claims.

Accordingly, claims 11-16 are believed patentable over the cited references and withdrawal of the rejections is respectfully requested.

VI. Conclusion

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all remaining claims, as amended in the subject patent application, should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of the patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 24-0037 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Dated: 4/26/05

By:



J. Steven Svoboda
Registration No. 44,366

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800
Facsimile: (415) 362-2928
e-mail: jss@fdml.com

Application No. 09/888,298
Xerox Ref.: D/A 1053
Atty Docket No.: XERX-01051 USN
SSvoboda/XERX/1051us0/Reply A as filed

13